

REMARKS

Applicants appreciate the Examiner's thorough examination of the subject application and request reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 1-21 are pending in the subject application.

Claims 14-21 were withdrawn from consideration as the result of an Examiner's earlier restriction requirement. In view of the Examiner's restriction requirement, Applicants reserve the right to present the above-identified withdrawn claims in a divisional application.

In the Office Action, Applicants were requested to affirm the election of claims 1-14. In this regard, Applicants hereby affirm the election of claims 1-13 and that claims 14-21 are non-elected claims.

Claims 1-13 stand rejected under 35 U.S.C. §102 and/or 35 U.S.C. §103.

Claim 3 was canceled and the limitations thereof were added to claims 1 and 2 respectfully.

Claims 4 and 5, which had depended from claim 3 (a multiple dependent claim) were amended so that each now depend respectfully from either claim 1 or claim 2. As claims 4 and 5 depended from a multiple dependent claim (claim 3), the amendment is supported by the original filed claims and Applicants also believe that additional claim fees are not required for such an amendment.

The amendments to the claims are supported by the originally filed disclosure.

35 U.S.C. §102 REJECTIONS

The Examiner rejected claim 6 under 35 U.S.C. §102(b) as being anticipated by Terada et al. [USP 5,276,541; “Terada”]. Applicants respectfully traverse.

Applicants claim, claim 6, a method of fabricating a liquid crystal panel. Such a method includes placing a sealing agent on a surface of a first substrate in a form of an enclosure and introducing liquid crystal on the first substrate in a region enclosed by the sealing agent or on a second substrate in a region corresponding to the region located on the first substrate enclosed by the sealing agent. Such a method also includes sticking the first substrate and the second substrate together to form a substrate formed of the first and second substrates and sticking a polarizing plate on at least one of the first substrate and second substrates. Further, such a method includes dividing the substrate to have a geometry providing a plurality of liquid crystal panels.

It should be first noted that Terada does not anywhere describe nor disclose dividing the substrate to form a plurality of liquid crystal panels. In fact, the discussion in col. 2, lines 55-61 of Terada indicates that the invention is Terada is directed to large area panels having high density.

The method described and taught in Terada corresponds in many respects to the conventional technique described in the subject application. The method described in Terada with specific reference to Figures 1 and 5-7 thereof (see also discussion at col. 4, line 37 - col. 5, line 22), does not disclose “placing a sealing agent on a surface of a first substrate in a form of an enclosure” and “introducing liquid crystal on said first substrate in a region enclosed by said

sealing agent or on a second substrate in a region corresponding to said region located on said first substrate enclosed by said sealing agent” as is claimed by Applicants.

Rather as clearly indicated in Figure 1 of Terada, a sealing agent or member is applied to a substrate in such a way that a gap or injection port 13 is created (steps (d) and (e) of Figure 1). Thereafter, the substrates are stacked together and the sealing agent or member is hardened by heating and pressurizing (steps (g) & (h) of Figure 1). Terada refers to the resultant at this stage of the process as the half-finished product (see col. 5 lines 5-7). According to the method in Terada, the liquid crystal material 19 is then injected into the space between the substrates 11, 17 (i.e., via the injection port 13) and the injection port is then sealed (steps (i) & (j) of Figure 1).

As indicated in the claim, the sealing agent is applied so as to form an enclosure on the substrate surface and the liquid crystal material is introduced so that it is either disposed in the region that is enclosed by the sealing agent or in a region on the other substrate that would correspond to the region that is enclosed by the sealing agent. It is clear that such a methodology is not disclosed, explicitly or inherently, anywhere in Terada.

As provided in MPEP-2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Or stated another way, “The identical invention must be shown in as complete detail as is contained in the ... claims. *Richardson v Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ 2d. 1913, 1920 (Fed. Cir. 1989). Although identify of terminology is not required, the elements must be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). It is clear from the

foregoing remarks that the above-identified claim is not anticipated by the cited reference.

In deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify *corresponding elements* disclosed in the allegedly anticipating reference (emphasis added, citations in support omitted). *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 730 F. 2d 1452, 221 USPQ 481,485 (Fed. Cir. 1984). In concluding that the '770 Patent did not anticipate the claims, the Federal Circuit in *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, at 221 USPQ 485-486, further provides that:

The '770 patent discloses an entirely different device,
composed of parts distinct from those of the claimed invention, and
operating in a different way to process different materials differently.
Thus, there is no possible question of anticipation by equivalents.
Citations omitted.

It is clear from the foregoing remarks that the method disclosed and taught in Terada for fabricating a liquid crystal panel is completely different from that claimed and taught by Applicants. It necessarily follows that the liquid crystal panel made using such a method has a structure that would be different from that described in Terada as well. Thus, there can be no disclosure or teaching in Terada of Applicants' invention.

It is respectfully submitted that for the foregoing reasons, claim 6 is patentable over the cited reference and thus satisfies the requirements of 35 U.S.C. §102(b). As such, claim 6 and the claims dependent therefrom, are allowable.

35 U.S.C. §103 REJECTIONS

Claims 1-5 and 11-13 stand rejected under 35 U.S.C. §103 as being unpatentable over the cited prior art for the reasons provided on pages 4-8 of the above-referenced Office Action.

Because claims were amended in the foregoing amendment, the following discussion refers to the language of the amended claim(s). However, only those amended features specifically relied on in the following discussion shall be considered as being made to overcome the prior art reference. The following addresses the specific rejections provided in the above-referenced Office Action.

CLAIMS 1-5

Claims 1-5 stand rejected as being unpatentable over the Poensgen et al. [USP 4,061,418; “Poensgen”] in view of Takeshi et al. [JP 54-0939951; “Takeshi”] for the reasons provided on pages 4-6 of the above referenced Office Action. Applicants respectfully traverse.

As grounds for the rejection, the above-referenced Office Action (see page 5) provides as to claim 3 that Poensgen teaches a liquid crystal panel where the sealing agent continuously surrounds an entire perimeter of the liquid crystal layer because of the term “hermetically sealed” in the abstract. Applicants respectfully disagree with the characterization of what is allegedly described/taught in Poensgen.

Applicants claim, claim 1, a liquid crystal panel in which a sealing agent is disposed between a first substrate and a second substrate to surround the liquid crystal layer. In contrast to

the present invention, Poensgen first teaches that the respective carrier plates *are connected at their margins by a spaced glass-solder frame* to form a hermetically sealed structure. See col. 2, lines 40-44 thereof. This disclosure/teaching hardly corresponds to teaching a sealing agent disposed between first and second substrates as is claimed by Applicants.

Poensgen also teaches/describes that the chamber formed between the two carrier plates is filled with a liquid crystal layer 6 through a suitable filing opening in the glass-solder frame or through an opening in one of the glass plates. Poensgen also specifically states that these filing openings are *not* illustrated in the figures. See col. 2, lines 44-48 thereof. Poensgen also teaches that this fill opening is tightly closed by means of a suitable closure material to complete the hermetically sealed structure.

In contrast, in the present invention and as claimed by Applicants, the sealing agent is disposed between the first and second substrates so as to surround the liquid crystal layer. In other words the sealing agent is disposed so no opening is formed therein which needs to be later sealed. In sum, Poensgen does not disclose, teach or suggest the present invention either explicitly or inherently.

Notwithstanding the foregoing, claim 1 was amended for clarity to provide that the sealing agent is applied to one of the first substrate or second substrate so as to continuously surround an entire perimeter of the liquid crystal layer. The term continuously surround an entire perimeter is clearly not embodied in the liquid crystal panel taught in Poensgen as that panel teaches the use of two elements to make up the hermetic seal, the glass-solder frame and the suitable closure material sealing the opening in one of the carrier plate or the glass-solder frame.

Applicants respectfully submit that the foregoing arguments also apply to distinguish the liquid crystal panel of claim 2 from the cited combination of references.

Applicants also submit that each of claims 4 and 5 depended respectfully from either claim 1 or claim 2. As such, it is submitted that each of claims 4 and 5 are considered to be allowable at least because of their dependency from an allowable base claim. This shall not be construed, however, as an admission that claims 4 and 5 are not separately patentable from the cited combination of references.

It is respectfully submitted that claims 1-5 are patentable over the cited reference(s) for the foregoing reasons.

CLAIMS 7-13

Claims 7-13 stand rejected under 35 U.S.C. §103 as follows. Claim 7 stands rejected under 35 U.S.C. §103 as being unpatentable over Terada et al. [USP 5,276,541; "Terada"] in view of Takeshi et al. [JP 54-0939951; "Takeshi"] for the reasons provided on page 6 of the above referenced Office Action. Claims 8-10 stand rejected under 35 U.S.C. §103 as being unpatentable over Terada et al. [USP 5,276,541; "Terada"] in view of Nagata et al. [JP 11-338376; "Nagata"] for the reasons provided on pages 6-7 of the above referenced Office Action. Claims 11 and 12 stand rejected under 35 U.S.C. §103 as being unpatentable over Terada et al. [USP 5,276,541; "Terada"] in view of Shimamune et al. [USP 5,684,556; "Shimamune"] for the reasons provided on page 7 of the above referenced Office Action. Claim 13 stands rejected under 35 U.S.C. §103 as being unpatentable over Terada et al. [USP 5,276,541; "Terada"] in

view of Shimamune et al. [USP 5,684,556; "Shimamune"] and further in view of Stefanov et al. [USP 5,953,289; "Stefanov"] for the reasons provided on pages 7-8 of the above referenced Office Action. Applicants respectfully traverse.

Each of claims 7-13 depends directly or ultimately from claim 6, the base claim. As indicated above, Terada does not disclose the method as set forth in claim 6. It also is respectfully submitted that Terada does not teach, or suggest the method as set forth in claim 6. In addition, it is respectfully submitted that Terada does offer any motivation, teaching or suggestion to modify the method disclosed and taught in Terada so as to yield the method as claimed by Applicants. Thus, it is respectfully submitted that each of claims 7 and 13 are allowable at least because of their dependency from an allowed base claim. This shall not be construed as an admission that claims 7-13 are not otherwise separately patentable over the cited art.

Applicants also would note that the secondary and tertiary references cited in connection with the §103 rejections are used for the alleged limited disclosure/teaching of the limitations embodied in the specific dependent claims. Thus, the secondary and tertiary references do not overcome the explicit and inherent deficiencies identified above regarding the primary reference, Terada. The foregoing shall not be construed as an admission, however, that the claims are not otherwise patentable over the identified combination of references.

It is respectfully submitted that claims 7-13 are patentable over the cited reference(s) for the foregoing reasons.

The following additional remarks shall apply to each of the above.

As provided in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As provided above, the references cited, alone or in combination, include no such teaching, suggestion or motivation.

Furthermore, and as provided in MPEP 2143.02, a prior art reference can be combined or modified to reject claims as obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, it also has been held that if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Further, and as provided in MPEP-2143, the teaching or suggestion to make the claimed combination and the reasonable suggestion of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As can be seen from the forgoing discussion regarding the disclosures of the cited references, there is no reasonable expectation of success provided in the reference(s).

As provided in MPEP-2145 (XD) a prior art reference that "teaches away" from the claimed invention is significant factor to be considered in determining obviousness. It also is provided therein that the totality of the prior art must be considered, and proceeding contrary to

accepted wisdom in the art is evidence of non-obviousness. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). As indicated herein, the methodologies described in both primary references as well as the display produced by such methods is directed to conventional arts and not to the methodology claimed by Applicants.

As the Federal circuit has stated, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. *Para-Ordnance Mfg. v. SGS Importers Int’l, Inc.*, 73 F.2d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995). In as much as both primary references are directed to conventional methods, it necessarily follows that a modification of the described methodology would be necessarily based on the teachings of the subject application.

It is respectfully submitted that for the foregoing reasons, claims 1-5 and 7-13 are patentable over the cited reference(s) and thus, satisfy the requirements of 35 U.S.C. §103. As such, these claims are allowable.

OTHER MATTERS

Applicants filed an Information Disclosure Statement dated February 27, 2004 when the subject application was initially filed in the USPTO, but have not received an initialed PTO-1449 reflecting the Examiner’s consideration of the subject art. Accordingly, Applicants respectfully request the Examiner to reflect their consideration of this IDS in the next official communication

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from the USPTO. In this regard, Applicants are enclosing herewith a copy of the IDS and PTO-1149 for the Examiner's convenience.


Applicants also filed an Information Disclosure Statement dated October 26, 2005, which postdates the above-referenced Office Action. Applicants respectfully request the Examiner to also reflect their consideration of this other IDS in the next official communication from the USPTO. Applicants also request the Examiner to contact the undersigned in the event that this other IDS needs to be re-submitted for consideration.

It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

Applicants believe that additional fees are not required for consideration of the within Response. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,
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